

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re the Application of:

GILBERT, et al.

Serial No.: 09/931,069

Filed: August 15, 2001

Confirmation No.: 2887

Atty. File No.: 818003 (50239-00002)

For: "DE-IDENTIFICATION AND
LINKAGE OF DATA RECORDS FOR
RE-IDENTIFICATION"

) Group Art Unit: 2137

) Examiner: POPHAM, Jeffrey D.

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STATEMENT OF REASONS FOR REQUESTING REVIEW

MAIL STOP AF

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Dear Sir or Madam:

The Applicant submits this Statement of Reasons for Requesting Review as an attachment to form PTO/SB/33 (07/05) and pursuant to Official Gazette Notices, July 12, 2005, Notice 12 ("New Pre-Appeal Brief Conference Pilot Program").

Review is respectfully requested for the above Patent Application. The Applicant respectfully submits that the Examiner has not shown where all of the claim elements of the Applicant's claims are taught as required in a *prima facie* rejection of independent claims 26, 30 and dependent claims 27 – 29 and 45. Specifically, in claims 26 and 30, he Applicant recites, among other things, a server computer that compares field level

encrypted match codes and links client de-identified records with mastered de-identified records based on the comparison. The Examiner states that Zubeldia does not teach a server but that Halmaka does. The Applicant argued that Halmaka (i.e., Halamka et al., “Managing Care in an Integrated Delivery System via an Intranet”, 1998, pages 1 – 5) does teach a server. However, that server only stores de-identified records. While Halmaka mentions a server on page 1, Halmaka simply does not teach or reasonably suggest a server that links client de-identified records with mastered de-identified records. There are many server applications in the world but that does not mean that the Examiner can just select any server to supplement a prior art reference. For example, in *In re Fine*, the court stated that “[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to depreciate the claimed invention.” *In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1988). Since, as the Examiner admits, Zubeldia does not teach linkage of the identified records on a server, claim 26 must be patentable in view of these references.

Additionally, in claims 27 and 45, the Applicant recites a feature of the server computer that enables the probabilistic linkage of client de-identified records with master de-identified records. The Examiner states that Garvin (i.e., Garvin et al., “Ensuing Statewide Newborn Screening by Linking the New Jersey’s Electronic Birth Certificate and Newborn Screening Databases”, 12/1/1998, pages 1 – 2) teaches probabilistic matching that can be used to supplement three other combined prior art references (i.e., Zubeldia, Morar, and Schneier). In this reference, the Applicant argued that Garvin only mentions the advantages of probabilistic matching over deterministic matching; but, Garvin does not teach any particular method of such probabilistic matching. The closest

thing that Garvin states is that such matching uses probabilistic weights based on frequencies of data elements, such as a match of “John” to “John” being weighted less than “Eibenizer” to “Eibenizer”. However, Garvin does not teach or reasonably suggest probabilistic linkage of client de-identified records with master de-identified records on a server.

The Examiner states now, for the first time in his advisory action, that Garvin teaches that "probabilistic matching is used in order to handle issues such as duplicated records, field format differences, and different hospital codes (slide 17), and that it will allow users to specify levels of variability in the matching of records, such as count differences, time, and date (slide 9)." The Examiner also mentioned that slide 7 of Garvin teaches probabilistic matching that will easily handle data entry errors, time/date data, etc.. The problem with each of these statements is that they are apparently part of a description that was never provided to the Applicant. Only two pages of an Internet download were provided to the Applicant and none of those pages contain the slides that the Examiner now mentions. In fact, Garvin was not even properly cited in a PTO-892 form. Even if though the website is provided, the Examiner never mentioned these other slides. To do so for the first time in an Advisory Action is just inappropriate.

Additionally, Garvin was apparently downloaded on August 19, 2005 (i.e., long after the Applicant's filing date). On the front page of the portion of Garvin that was presented to the Applicant, there is merely a reference that states that such was “[p]resented at a 1998 Annual Maternal, Infant, and Child Health Epidemiology Workshop”. However, the actual date of the reference is August 19, 2005. Such a statement is analogous to hearsay.

Based upon the foregoing, the Applicant believes that all pending claims are in condition for allowance and such disposition is respectfully requested. At the very least, the Examiner should issue a new office action that allows the Applicant to properly address the references. In the event that a telephone conversation would further prosecution and/or expedite allowance, the Examiner is invited to contact the undersigned.

Respectfully submitted,

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